

Remarks

Regarding lines 4) and 6) of the "Disposition of Claims" as presented in the Office Action Summary, it appears that claims 36 and 96 should be included (See May 2004 Amendment and Response), and claim 95 (canceled in that response) should be deleted.

The rejected claims are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. 5,385,551 to Shaw. The '551 patent issued January 31, 1995, and that date is its effective date as a prior art reference under 102(b).

This application is a continuation of 08/843,050 (04/25/1997), now U.S. 6,090,077; which is a CIP of 08/537,242 (09/29/1995), now U.S. 5,632,733; which is a CIP of 08/438,954 (05/11/1995), now U.S. 5,578,011. Thomas J. Shaw is the sole named inventor on each of these applications and patents.

Applicant will show below that principal elements of the inventions recited in each presently rejected claim were first disclosed in, and carried forward from, the 1995 applications that became the '011 and '733 patents, and were not disclosed in the '551 patent now being cited. Because the '551 patent issued less than a year prior to the effective 1995 filing dates of the applications that became the '011 and '733 patents, it cannot properly be cited as a 102(b) reference against that subject matter. Furthermore, because principal elements of the rejected claims are not disclosed in the '551 patent, it cannot in any event be relied upon in support of a 102(b) rejection.

Seven independent claims are presently rejected: 29, 37, 45, 54, 56, 81 and 96. Each is addressed below.

Each of claims 29, 37, 45, 56 and 81 (and the dependent claims depending from them) recites a combination of features that are not previously disclosed in the '551 patent. Without limitation, those include (see the last subparagraph of each respective claim) what we refer to as the "tucking" feature whereby the plunger end cap is received into the back end of the syringe body during retraction, where it cannot thereafter be grasped by the user and again withdrawn for subsequent use. That feature is not disclosed in the '551 patent of Shaw but is disclosed (e.g., at FIG. 3, 4B) in the '011 and '733 patents and in the same figures of the present application. The '551 patent cannot, therefore, anticipate those claims.

Each of claims 54 and 81 (and the dependent claims depending from them) recites a combination of features that are not previously disclosed in the '551 patent. Without limitation, those include (see the next-to-last subparagraph of claim 54 and the third subparagraph of claim 81) what we refer to as the "forwardly extending tip" feature whereby the forward tip of the needle holder extends beyond the biasing element, and in fact, beyond the front (76) of the nose (16) of the syringe body (12). That feature is not disclosed in the '551 patent of Shaw but is disclosed (e.g., at FIG. 1) in the '011 and '733 patents and in the same figure of the present application. The '551 patent cannot, therefore, anticipate those claims.

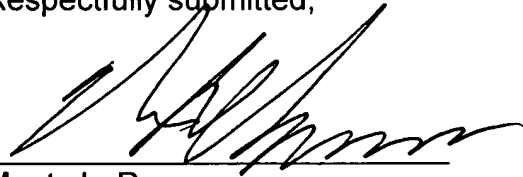
Claim 96 recites a combination of features that are not previously disclosed in the '551 patent. Without limitation, those include (see the last subparagraph of claim 96) what we refer to as the "spring guide" feature whereby the inside wall of body (12) and the needle holder (26) cooperate as a spring guide during compression of the spring (24). That feature is not disclosed in the '551 patent of Shaw (where a wide space visible between the inside wall and the needle holder permits buckling of the spring during compression) but is disclosed (e.g., at FIG. 1) in the '011 and '733 patents and in

the same figure of the present application. The '551 patent cannot, therefore, anticipate that claim.

For the foregoing reasons, Applicant respectfully requests that the rejection be withdrawn and that all pending claims be passed to issue.

Applicant respectfully requests that a timely Notice of Allowance be issued in this case. Please charge any additional fee that may be required or credit any overpayment to Deposit Account No. 12-1781 of Locke Liddell & Sapp, LLP.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Monty L. Ross', written over a horizontal line.

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